

REMARKS

I. Introduction

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1 through 34 are cancelled. Claims 35 and 36 are requested to be cancelled. The cancellation of claims does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicants reserve the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

Claim 37 is currently being amended.

Claims 38-41 are being added.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Exemplary support for the amendments to claim 37 is found in the specification on page 32, line 14 and on page 53, line 16, through page 54, line 18. Exemplary support for newly added claims 38-41 is found through the specification. *See, e.g.*, original claim 12, page 32, line 14 and page 53, line 16, through page 54, line 18.

Upon entry of this Amendment, claims 37-41 will remain pending in the application.

Because the foregoing amendments do not introduce new matter, entry thereof by the Examiner is respectfully requested.

II. Response to Issues Raised by Examiner in Outstanding Office Action

a. Claim Rejections - 35 U.S.C. § 112, Second Paragraph

Claims 36 and 37 are rejected by the Examiner under 35 U.S.C. § 112, second paragraph as being allegedly indefinite. Applicants respectfully request reconsideration and withdrawal of the rejection.

The Examiner asserts that it is unclear how claims 36 and 37 further limit claim 35. Applicants respectfully disagree with the Examiner. However, to expedite prosecution, Applicants have canceled claims 35 and 36. Therefore, the rejection is moot.

b. Claim Rejections - 35 U.S.C. § 112, First Paragraph

Claims 35-37 are rejected by the Examiner under 35 U.S.C. § 112, first paragraph for lack of written description. The Examiner asserts that the recitation of a PTP05 polypeptide is not limited by a functional attribute nor by a structural attribute. The Examiner also asserts that the description of SEQ ID NOS: 5, 6 and 7 are not representative of a genus of PTP05 polypeptides because the genus tolerates members which lack tyrosine phosphatase activity, and the proteins of SEQ ID NOS: 5, 6 and 7 are not representative of tyrosine-phosphatase lacking proteins. Applicants respectfully request reconsideration and withdrawal of the rejection.

Applicants respectfully disagree with the Examiner's assertions. However, to expedite prosecution, Applicants have canceled claims 35 and 36 and have amended claim 37 parts b, c and d to recite that the polypeptide has tyrosine phosphatase activity. Applicants have also amended claim 37 parts b, c and d so that the polypeptide contains a catalytic domain. Exemplary support for the amendments to claim 37 is found in the specification on page 32, line 14 and on page 53, line 16, through page 54, line 18.

c. Claim Rejections - 35 U.S.C. § 102

i. Rejection of Claim 35 as Being Anticipated by Jones et al.

Claims 35 and 37 are rejected by the Examiner under 35 U.S.C. § 102 as being anticipated by Jones et al. (JBC, 1989, 263L7747-7753). The Examiner asserts that "when

given the broadest reasonable interpretation, claim 37 encompasses amino acid sequences lacking all of the residues of SEQ ID NO: 5, because lacking "one or more" of residues 1-187, 188-420 and 421-426 can read on lacking all. Thus, the Examiner states that the PTP-5 protein of Jones et al. anticipates claims 35 and 37 because the PTP-5 of Jones et al. lacks residues 1-187, 188-420 and 421-426 of SEQ ID NO: 5. Applicants respectfully request reconsideration and withdrawal of the rejection.

Applicants have canceled claim 35, thus rendering the rejection of claim 35 moot. The cancellation of claims does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicants reserve the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

With respect to claim 37, claim 37, as amended, is not anticipated by Jones et al. Applicants have amended claim 37, parts b, c and d so that the polypeptide contains a catalytic domain. Therefore, the polypeptides of claim 37, parts b, c and d do not lack all of the amino acid sequences contained in SEQ ID NOS: 5, 6 and 7. As such, claim 37 is not anticipated by Jones et al.

Furthermore, claim 37 is directed to the polypeptides of SEQ ID NOS: 5, 6 and 7 and domains thereof. Nowhere in Jones et al. are SEQ ID NOS: 5, 6 and 7 and domains thereof taught or suggested. Therefore, claim 37 is not anticipated by Jones et al.

ii. Rejection of Claims 35 and 37 as being anticipated by Ahmad et al.

Claims 35 and 37 are rejected by the Examiner under 35 U.S.C. § 102 as being anticipated by Ahmad et al. (Journal of Clinical Investigation, 1995, 85:2806-2812). The Examiner asserts that the polypeptides of SEQ ID NOS: 5, 6 and 7 would inherently be enriched in the infranate of Ahmad et al. Applicants respectfully request reconsideration and withdrawal of the rejection.

Applicants have canceled claim 35, thus rendering the rejection of claim 35 moot. The cancellation of claims does not constitute acquiescence in the propriety of any rejection

set forth by the Examiner. Applicants reserve the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

With respect to claim 37, this claim, as amended, is not anticipated by Ahmad et al. because Ahmad et al. fails to teach each and every limitation of the claim. Claim 37 is directed to the polypeptides of SEQ ID NOS: 5, 6 and 7 and domains thereof. Nowhere in Ahmed et al. are SEQ ID NOS: 5, 6 and 7 and domains thereof taught or suggested. Therefore, claim 37 is not anticipated by Ahmed et al.

d. Claim Rejections - 35 U.S.C. § 103

Claims 35 and 37 are rejected by the Examiner under 35 U.S.C. § 103 as being obvious over Norris et al. (FEBS Letters, 1997, 415:243-248). The Examiner asserts that it would have been obvious at the time of the invention to express the DNA clones identified in Table 1 of Norris et al. to produce the corresponding translated polypeptides because Norris et al. suggests that a different protein tyrosine phosphatase other than PTP-LAR was involved in signal transduction from the insulin receptor. Applicants respectfully requests reconsideration and withdrawal of the rejection.

Applicants have canceled claim 35, thus rendering the rejection of claim 35 moot. The cancellation of claims does not constitute acquiescence in the propriety of any rejection set forth by the Examiner. Applicants reserve the right to pursue the subject matter of the canceled claims in subsequent divisional applications.

With respect to claim 37, this claim, as amended is not obvious over Norris et al. Claim 37 is directed to the polypeptides of SEQ ID NOS: 5, 6 and 7 and domains thereof. Nowhere in Norris et al. are SEQ ID NOS: 5, 6 and 7 and domains thereof taught or suggested. The claimed sequences are not taught or suggested in Table 1 or any other location of Norris et al.

At best, the Examiner is using an improper “obvious to try” standard. However, “‘obvious to try’ has long been held to not constitute obviousness.” *In re Deuel*, 51 F.3d

1552, 1559, 34 USPQ2d 1210 (Fed. Cir. 1995). Furthermore, as discussed above, the claimed sequences are not taught or suggested in Table 1 or any other location of Norris et al.

e. New Claims 38-41

New claims 38-41 are free of the prior art for the reasons discussed above. New claims 38-41 are added to more clearly define claim scope.

CONCLUSION

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

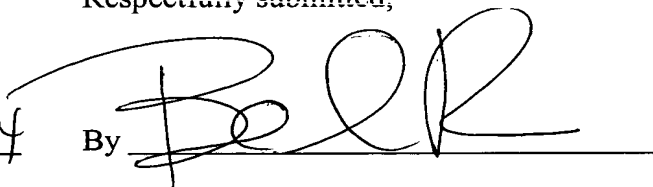
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant(s) hereby petition(s) for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date

23 September 2004

By



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